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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,879	08/18/2003	David Morrow	WLI 1063 PUS	3318

59582 7590 05/15/2008  
DICKINSON WRIGHT PLLC  
38525 WOODWARD AVENUE  
SUITE 2000  
BLOOMFIELD HILLS, MI 48304-2970

EXAMINER
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CHAMBERS, MICHAEL S

ART UNIT	PAPER NUMBER
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3711

MAIL DATE	DELIVERY MODE
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05/15/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/642,879	<b>Applicant(s)</b> MORROW ET AL.	
	<b>Examiner</b> MIKE CHAMBERS	<b>Art Unit</b> 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 41-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/22/07</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 41 is rejected under 35 U.S.C. 102(b) as being anticipated by HauteStick. HauteStick discloses a hollow tube having an interior surface and an exterior surface and extending a length along a longitudinal axis between a first end and a second end wherein one of said first and second ends is operable for attachment to a lacrosse head and said hollow tube having a wall thickness defined in a plane normal to said longitudinal axis between said interior surface and said exterior surface, wherein said wall thickness varies about said longitudinal axis in said plane and includes a first range

about said longitudinal axis of relatively thicker wall thickness and a second range about said longitudinal axis of relatively thinner wall thickness, said first range and said second range operably associated with one another whereby said hollow tube is operable to provide tactile feedback to a user of said hollow tube as to the orientation of said hollow tube in the user's hand (See NPL HauteStick pgs 1-5).

Claims 41- 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrow et al (5568925) in view of Merola (3697069) and HauteStick. Morrow discloses a hollow shaft (fig 1, 3:46-49). HauteStick discloses it is old to desire to strengthen a portion of the shaft to increase its strength for checking the user's opponent (page 4). Merola discloses an eccentric shaft (fig 5). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the eccentric cross sectional shape of Merola with Morrow in order to increase the strength of the shaft for checking during play.

As to claims 42 and 43: Merola discloses a substantially constant wall thickness with a first range of at least 120-180 degrees (fig 5). Note: The specification provides no unexpected or surprising results in using limitation; therefore it is considered a design choice. It would have been obvious to one of ordinary skill in the art to have selected any one of several first ranges based on the design criteria of the machines making the extruded shafts.

As to claim 44: The specification provides no unexpected or surprising results in using limitation; therefore it is considered a design choice. An eccentric shaft having a hexagonal cross sectional shape would naturally have multiple ranges of thicknesses.

As to claim 45: Merola discloses a substantially constant wall thickness around a first and second range (fig 5).

As to claims 46-48: The specification provides no unexpected or surprising results in using these limitations; therefore they are considered design choices. The amount of eccentricity to a shaft and this wall thickness depends on the limitations of the equipment and the desires of the person designing the shaft.

As to claim 49: Morrow discloses a polygonal cross-sectional shape (3:46-49).

As to claim 50: The specification provides no unexpected or surprising results in using limitation; therefore it is considered a design choice. An eccentric shaft having a hexagonal cross sectional shape would naturally have over half the sides thicker since walls adjacent the thicker wall would have thin and thick wall segments. And thus could be counted with either the thick or thin wall segments.

As to claim 51: Morrow discloses a polygonal cross-sectional tube with adjacent sides (3:46-49). The eccentric shaft of Merola would naturally have this limitation in an octagonal shaped shaft.

As to claim 52: The eccentric shaft of Merola using the octagonal shaped shaft of Morrow would naturally have this limitation depending on where the axis was drawn. The specification provides no unexpected or surprising results in using these limitations; therefore they are considered design choices.

As to claim 53: The eccentric shaft of Merola would naturally have this limitation in an octagonal shaped shaft. The specification provides no unexpected or surprising results in using these limitations; therefore they are considered design choices.

### ***Response to Arguments***

Applicant's arguments filed 1/17/08 have been fully considered but they are not persuasive. It is still unclear to the examiner how the user can obtain any tactile feedback from the lacrosse stick given that the only difference between the sides of the shaft is the sidewall thickness. This thickness is not noticeable when viewing the exterior of the shaft. Therefore how tactile feedback is obtained is unclear.

The intended use of the stick breaths no life into the structural limitations of the claim. As currently stated, the HauteStick meets the structural limitations of claim 41.

With regard to the Morrow and Merola references, the octagonal shape of the shaft will provide the different thicknesses as claimed once it takes on the cross sectional variation of the Merola shaft. Merola is being used to increase the structural strength of the Morrow shaft. Once the references are combined, they structurally meet the limitations of the instant invention.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Chambers whose telephone number is 571-272-4407. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Chambers  
Examiner  
Art Unit 3711

May 10, 2008

/Gene Kim/

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